

ATTY. DOCKET NO. 119166.1009 (LEDS.00119)
CUSTOMER NO. 38851

AMENDMENT
SERIAL NO. 10/736,346

REMARKS/ARGUMENTS

This Application has been carefully reviewed in light of the Office Action mailed June 27, 2006. Claims 1-27 were filed in this Application of which claims 1, 10, 14-16, 19, 23-25 were previously amended, no claims are currently amended and no claims are currently added. Thus, Claims 1-27 are currently pending in this Application.

The drawings were objected to by the Examiner. Replacement drawings are submitted herewith to correct the view numbers as requested by the Examiner. No new matter was added to the specification as a result of these replacement drawings. In view of these replacement drawings and the following remarks, Applicants respectfully submit that all of the claims of the above-identified application are in condition for allowance. Reconsideration of the claims is respectfully requested.

I. Objections to the Drawings

The Examiner has objected to drawings because the view numbers are not in accordance with 37 CFR §1.84(u)(1). Appropriate corrections to the drawings have been made in the replacement drawings which are submitted along with this response.

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II. 35 U.S.C. § 103, Obviousness (Claims 1-7, 9-16, 18-25, and 27)

The examiner has rejected claims 1-7, 9-16, 18-25, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Jones (US PG Pub 2002/0188841) in view of Gourlay et al., (U.S. Pat. No. 6,920,498). This rejection is respectfully traversed.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). In response to an assertion of obviousness by the Patent Office, the applicant may attack the Patent Office's *prima facie* determination as improperly made out, present objective evidence tending to support a conclusion of nonobviousness, or both. *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

In rejecting claim 1, the Examiner states that "Jones does not specifically mention that querying the central registry involves accessing a list of storage locations containing the requested digital asset, determining which storage location is "nearest", and determining the local knowledge management

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server having access to that nearest storage location. However, such optimized data retrieval was well known in the art and is the [sic] fundamental to the operation of most computer networks, including the internet. Gourlay et al. taught an example of such, including creating a list of storage locations and their distance from a fixed location ... and choosing the content serving the site (management server) with the shortest access times." The Examiner further states that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the data retrieval optimization of Gourlay et al. into the system of Jones, since the two systems were compatible structures and the combination would have been more efficient by providing faster retrieval of data."

A prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). The inquiry is not whether each claimed element existed in the prior art, but whether the invention as a whole is obvious in light of the prior art. The mere fact that the prior art could be readily modified to arrive at the claimed invention does not render the claimed invention obvious; the prior art must suggest the desirability of such a modification. *In re Ochiai*, 71 F.3d 1565, 1570, 37 U.S.P.Q.2d 1127, 1131 (Fed. Cir. 1996); *In re Gordon*, 733 F.2d 900, 903, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Merely stating that the modification would have been obvious to one of ordinary skill without identifying an incentive or motivation for making the proposed modification is insufficient to establish a prima facie case. In determining whether particular references might be properly combined,

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whether it is obvious to try a combination is not a legitimate test. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988). The test is whether the combination of the references or modification would be obvious to ~~do~~ rather than obvious to ~~try~~. *In re Deuel*, 51 F.3d 1552, 1559, 34 U.S.P.Q.2d 1210, 1216 (Fed. Cir. 1995). A general incentive does not make obvious a particular result, nor does the mere existence of techniques which may be carried out to achieve the particular result. *Id.*

In the present case, the Examiner has merely stated that it would have been obvious to combine Jones with Gourlay et al. because it would have allegedly resulted in the method as claimed in the present application because the combination would have been more efficient by providing faster retrieval of data. However, this supposed motivation is nothing more than using hindsight based on the implicit teachings of the present application to provide the motivation. This is impermissible. In determining obviousness, an applicant's teachings may not be read into the prior art. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1575 n. 29, 1 U.S.P.Q. 1593, 1602 n. 29 (Fed. Cir. 1987) (citing need to "guard against hindsight and the temptation to read the inventor's teachings into the prior art"). A determination of the desirability of combining prior art references must be made without the benefit of hindsight afforded by an applicant's disclosure. *In re Paulsen*, 30 F.3d 1475, 1482, 31 U.S.P.Q. 1671, 1676 (Fed. Cir. 1994).

Thus, the Examiner's has not met the Patent Office's burden of providing a *prima facie* case of obviousness since the Examiner has provided no motivation to combine Jones with Gourlay et al. other than a general statement that the combination of the two would be a more efficient method of

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retrieval of data. Such an assertion assumes the outcome rather than motivates the outcome. As such, it is an impermissible use of the applicant's teachings to provide the missing motivation to combine the two references.

Therefore, claim 1 is not rendered obvious by Jones in view of Gourlay et al.

Claims 10 and 19 contain similar features to those of claim 1. Therefore, the arguments in favor of patentability for claim 1 apply to claims 10 and 19 as well. Therefore, claims 10 and 19 are not rendered obvious by Jones in view of Gourlay et al.

Claims 2-7, 9, 11-16, 18, 20-25, and 27 depend from respective ones of claim 1, 10, and 19 and contain all of the limitations of the claim from which they depend as well as additional limitations. Therefore, claims 2-7, 9, 11-16, 18, 20-25, and 27 are not rendered obvious by Jones in view of Gourlay et al.

Therefore, the rejection of claims 1-7, 9-16, 18-25, and 27 under 35 U.S.C. § 103(a) has been overcome.

III. 35 U.S.C. § 103, Obviousness (Claims 8, 17, and 26)

The examiner has rejected claims 8, 17, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Jones (US PG Pub 2002/0188841) in view of Gourlay et al., (U.S. Pat. No. 6,920,498) and further in view of Kobata (US PG Pub 2002/0077986). This rejection is respectfully traversed.

Claims 8, 17, and 26 depend from claims 1, 10, and 19. Therefore, the arguments in support of patentability presented above with respect to claims 1, 10, and 19 apply equally to claims 8, 17, and 26. Therefore, claims 8, 17, and 26 are not

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rendered obvious by Jones in view of Gourlay et al. further in
view of Kobata.

Therefore, the rejection of claims 8, 17, and 26 under 35
U.S.C. § 103(a) has been overcome.

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IV. CONCLUSION

It is respectfully urged that the subject application is patentable over Jones, Gourlay et al., and Kobata and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Applicants hereby authorize the Commissioner to charge any additional fees or refunds that may be required by this paper to Electronic Data Systems Corporation Deposit Account No. 05-0765. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to Electronic Data Systems Corporation Deposit Account No. 05-0765.

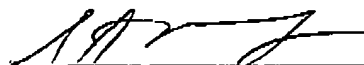
If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below.

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**Please direct all correspondence to the practitioner
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Respectfully submitted,



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